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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DUONG, THOMAS

ART UNIT PAPER NUMBER

2145

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/760,327	Applicant(s) CHILOYAN ET AL.	
	Examiner Thomas Duong	Art Unit 2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-2, 4-6 and 8-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-6 and 8-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on August 30, 2004. The amendment filed on August 30, 2004 has been entered and made of record. *Claims 1-2, 4-6 and 8-37* are presented for further consideration and examination.

Response to Argument

2. The Applicants' arguments and amendments filed on August 30, 2004 have been fully considered, but they are not persuasive.
3. With regard to *claims 1 and 23*, the Applicants point out that:
 - *It appears as if Leigh is reading the network address directly as opposed to being providing a pointer to access the location in a memory within the peripheral device, because there is no mention of a pointer being used in Leigh.*
 - *Since there is no teaching or suggestion in Leigh of providing a pointer to an addressable location in a memory of the peripheral device, it is evident that this aspect of applicants' claimed invention is not anticipated or obvious over Leigh.*

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that the Leigh reference does disclose,

- *said step of transferring comprising the steps of:*

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- *providing a pointer to a location in the addressable memory of the peripheral device at which the network address is stored;*
- *communicating the pointer to the host device;*
- *using the pointer to access the location in the addressable memory of the peripheral device; and*
- *communicating the network address to the host device from said location. (Leigh, col.1, lines 65-66; col.2, lines 1-3, lines 45-48, lines 50-51; col.3, lines 1-6, lines 19-23; module 310, fig.3)*

Leigh teaches of connecting the peripheral device to the destination computer and transferring the stored network address in the peripheral device to the destination computer. According to Leigh, *"the memory device can be a register, or the like, and stores the device identification (ID), and a network address, such as Universal Resource Locator (URL)"* (col.3, lines 3-6). Since the register is used to hold the actual interested data, the common idiom for accessing this register or memory location is to use a pointer whose value contains the register's address. Hence, in effect, what the Applicants is claiming is the conventional known process to access the data stored in a register using a programming pointer. Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

4. With regard to claims 1 and 23, the Applicants point out that:

- *However, the Examiner does not provide a citation to any portion of Fleming where the prior art discloses or suggests requesting permission of a user in order to communicate with a source, or once permission is*

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received from the user, initiating the communication between the host device and the source.

However, the Examiner finds that the Applicants' arguments are not persuasive and maintains that the Fleming reference does imply,

- *said step of enabling communications comprising the steps of:*
 - *requesting permission of a user to communicate with the source;*
and
 - *upon receiving permission to do so from the user, initiating the communication between the host device and the source to obtain information from the source pertaining to the peripheral device.*
- (Fleming, col.2, lines 6-10, lines 46-49; col.4, lines 17-20, lines 42-45)

Fleming states that by making *"the current driver accessible at a location specified by [a] URL on [the] network"* (col.4, lines 42-44), *"[it] allows current driver to be retrieved by a requester across the network"* (col.4, lines 44-45).

This implies an interaction with the user or requester in order to access and retrieve the necessary driver from the network. Furthermore, according to Leigh, it is well known in the networking art, that *"a user must respond to a series of queries or prompts to install the driver onto the computer"* (col.1, lines 40-42). Hence, there is no novelty in requesting the user permission to communicate with the source in order to obtain the desired data as claimed.

In addition, the Applicants also states that:

"connecting to the Internet and/or downloading drivers and other software materials is also a manual, time-consuming process that most users would prefer to avoid. In addition, such a manual process can present a

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problem for novice users, can delay the initial installation of a newly purchased peripheral device on a computer, and will clearly detract from user satisfaction with the peripheral device” (specification, pg.3, lines 29-35) and

“From the preceding discussion, it will be apparent that it would be preferable to enable the operating system on a computing device to automatically obtain any device driver required and any related software/document materials pertaining to a peripheral device that has just been connected to the computing device for the first time from a designated remote site via the Internet (or other network)” (specification, pg.4, lines 1-5).

Hence, the Applicants have already teaches away from involving user interactions in favor of a *“fully automated”* process. Therefore, the Applicants still failed to clearly disclose the novelty of the invention and identify specific limitation, which would define patentable distinction over prior art.

5. With regard to claims 2, 4-6, 8-22 and 24-37, they are rejected at least by virtual of their dependency on the independent claims and by other reasons set forth in the previous office action. Accordingly, rejections for *claims 2, 4-6, 8-22 and 24-37* are presented as below:

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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7. Claims 1-2, 4, 8-18 and 22-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Leigh (US006728787B1).
8. With regard to claims 1 and 22-23, Leigh reference discloses,
- *providing a network address (network address 232) in a storage (non-volatile memory 231) of the peripheral device (peripheral device 230);* (Leigh, col.1, line 66 – col.2, line 1; col.2, lines 35-38; modules 230-232, fig.1; Leigh teaches of storing a network address and a device identification in a non-volatile memory of the peripheral device)
 - *when the peripheral device is coupled to a host device (destination computer 200), transferring the network address from the peripheral device to the host device,* (Leigh, col.1, lines 65-66; col.2, lines 1-3; col.3, lines 19-21; module 310, fig.3; Leigh teaches of connecting the peripheral device to the destination computer and transferring the stored network address in the peripheral device to the destination computer)
 - *said step of transferring comprising the steps of:*
 - *providing a pointer to a location in the addressable memory of the peripheral device at which the network address is stored;*
 - *communicating the pointer to the host device;*
 - *using the pointer to access the location in the addressable memory of the peripheral device; and*
 - *communicating the network address to the host device from said location.* (Leigh, col.1, lines 65-66; col.2, lines 1-

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3, lines 45-48, lines 50-51; col.3, lines 1-6, lines 19-23;
module 310, fig.3)

- *enabling communication between the host device and a source (source computer 300) indicated by the network address, said communication pertaining to the peripheral device. (Leigh, col.2, lines 3-9, lines 33-34; col.3, lines 6-16, lines 21-23; Leigh teaches of connecting the destination computer to the source computer using the stored network address in the peripheral device and retrieving device drivers for the peripheral device)*
 - *said step of enabling communications comprising the steps of:*
 - *requesting permission of a user to communicate with the source; and*
 - *upon receiving permission to do so from the user, initiating the communication between the host device and the source to obtain information from the source pertaining to the peripheral device. (Fleming, col.2, lines 6-10, lines 46-49; col.4, lines 17-20, lines 42-45)*

9. With regard to claims 2, 4, 8-10 and 24-26, Leigh reference discloses,

- *wherein the step of providing comprises the step of storing the network address in an addressable memory of the peripheral device. (Leigh, col.1, line 66 – col.2, line 1; col.2, lines 35-38; col.3, lines 1-3; modules 230-232, fig.1; Leigh teaches of storing a network address and a device identification in a non-volatile memory of the peripheral device)*

10. With regard to claims 11-18 and 27-34, Leigh reference discloses,

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- *wherein the step of enabling communication comprises the step of automatically retrieving at least one of data, machine instructions, and a document pertaining to the peripheral device from the source indicated by the network address. (Leigh, col.2, lines 3-9; col.3, lines 6-16; Leigh teaches of connecting the destination computer to the source computer using the stored network address in the peripheral device and retrieving device drivers for the peripheral device)*
- *wherein the step of enabling communication comprises the step of automatically executing a setup program obtained from the source and pertaining to the peripheral device. (Leigh, col.2, lines 3-9; col.3, lines 6-16, lines 24-33)*
- *wherein the step of enabling communication comprises the step of automatically installing a device driver program pertaining to the peripheral device, on the host device. (Leigh, col.2, lines 3-9; col.3, lines 6-16; Leigh teaches of connecting the destination computer to the source computer using the stored network address in the peripheral device and retrieving device drivers for the peripheral device)*
- *wherein the step of enabling communication comprises the step of automatically downloading and installing updated firmware into the peripheral device. (Leigh, col.2, lines 3-9; col.3, lines 6-16, lines 42-45)*

Claim Rejections - 35 USC § 103

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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12. Claims 5-6, 19-21 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leigh (US006728787B1) and in view of Fleming (US006473854B1).

13. With regard to claims 5-6, 19-21 and 35-37, Leigh reference discloses the invention substantially as claimed,

See *claims 1 and 23* rejection as detailed above.

However, Leigh reference does not explicitly disclose,

- *further comprising the step of detecting a change in the number of peripheral devices connected to the host device to determine when the peripheral device is connected to the host device.*

Fleming teaches,

- *further comprising the step of detecting a change in the number of peripheral devices connected to the host device to determine when the peripheral device is connected to the host device.* (Fleming, col.2, lines 1-10, lines 18-23; col.4, lines 25-32)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Fleming reference with Leigh reference to enable a device for utilization upon detection of its presence by automatically retrieving from a locator specifying the location (network address) that is stored in the memory of the device and installing the device driver once it is retrieved.


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Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.
15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Duong whose telephone number is 571/272-3911. The examiner can normally be reached on M-F 7:30AM - 4:00PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on 571/272-3923. The fax phone numbers for the organization where this application or proceeding is assigned are 703/872-9306 for regular communications and 703/872-9306 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571/272-2100.

Thomas Duong (AU2145)

December 2, 2004


Jason CARBONE
Per my ex.
AU:2145